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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,214	03/31/2000	Jay S. Walker	00-006	9740
22927	7590	06/22/2004	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/540,214

Applicant(s)

WALKER ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25-41 and 43-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23, 25-41 and 43-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-23, 25-41, 43-97 have been examined.

### **Continued Examination Under 37 CFR 1.114**

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/15/04 has been entered.

### ***Response to Amendment***

3. The Amendment filed on 4/15/04 is sufficient to overcome the Bergh, Scroggie, and Kanter reference.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-15, 17-21, 25-41, 43-47, and 49-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergh (6,112,186) in view of Scroggie (5,970,469) in further view of Von Kohorn (5,227,874).

Claim 1, 7, 10, 17-21, 29, 37-41, 43-45, and 49-96: Bergh discloses a system and method for:

receiving from a customer an indication of a product category or a service category (col 3, lines 17-25; col 1, lines 24-32; col 11, lines 5-7; col 11, lines 49-53; col 27, lines 9-14). Additionally, If a user can become more experienced in a particular domain, as Bergh discloses (col 11, lines 49-53), it is inherent that that user is selecting that domain more regularly. Bergh also discloses that the user can choose different product categories by selecting different websites (col 28, lines 5-11; col 28, lines 18-22). Bergh also discloses that user category and item selection in different categories can be interconnected (col 28, lines 10-15; col 28, lines 20-25; col 28, lines 49-53).

Bergh further discloses selecting for the customer one of the products in the product category or the services in the service category (col 27, lines 17-20; col 27, lines 27-30; col 27, lines 65-col 28, lines 2; col 1, lines 50-54).

Bergh further discloses providing an indication of said selected one of said at least two products or said at least two services (col 27, lines 17-20; col 27, lines 27-30; col 27, lines 65-col 28, lines 2).

Bergh further discloses a retailer category (col 1, lines 24-32; col 3, lines 17-25) where the retailer category is restaurants, clothing stores, World Wide Web pages, etc.

Bergh further discloses that the user makes a purchase (col 27, lines 65-col 28, lines 2).

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Bergh does not explicitly disclose arranging for a benefit to be provided if the product or service selected for the customer has been purchased.

However, Scroggie discloses arranging for a benefit to be provided if the product or service selected for the customer has been purchased (col 7, lines 65-67; col 8, lines 28-30; col 5, lines 62-65; col 6, lines 7-13). It is inherent to rebates that they provide a benefit if the product or service has been purchased.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Scroggie's rebate for a purchase made to Bergh's customer selecting a product category and subsequent item recommendation. One would have been motivated to do this because a rebate is an obvious way of encouraging a customer to purchase a product.

Bergh nor Scroggie explicitly disclose selecting, for a customer, one of the products from a first product and a second product, where the customer had indicated

The first product and the second product, and

A willingness to purchase any one of the first product and the second product.

However, Von Kohorn discloses

Selecting, for a customer, one of the products from a first product and a second product, where the customer had indicated

The first product and the second product, and

A willingness to purchase any one of the first product and the second product (col 99, line 37-col 100, line 5).

Von Kohorn further discloses indicating an area of interest (col 98, lines 33-36).

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Von Kohorn further discloses targeting user with differing incentives (col 104, line 65-col 105, line 3; col 105, lines 17-24).

Von Kohorn further discloses targeting information to select groups of users (col 78, lines 40-52).

Von Kohorn further discloses utilizing competitive advertising to induce purchasing (col 105, lines 45-52) and that advertising can be in the form of incentives or coupons (col 8, lines 40-44; col 100, lines 60-68).

Von Kohorn further discloses that products from several sponsors can be provided as potential items of interest (col 83, lines 39-43).

Von Kohorn further discloses that the product can be a service or organization (col 100, lines 40-45) and that an organization can be a retailer (col 76, line 67-col 77, line 5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn targeting user's based on items of interest for purchasing to Bergh's targeting user's based on items of interest and user making purchases. One would have been motivated to do this in order to allow flexible incentives for purchasing to be presented to users based on user interests.

Claims 2 and 30: Bergh and Scroggie and Von Kohorn disclose a method as in claims 1 and 29, and Bergh further discloses that said indication of said selected one of said at least two products or said at least two services is provided to at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 3 and 31: Bergh and Scroggie and Von Kohorn disclose a method as in claims 1 and 29, and Bergh further discloses that said indication of said selected one of said at least two products or said at least two services is provided by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 4 and 32: Bergh and Scroggie and Von Kohorn disclose a method as in claims 1 and 29, and Bergh further discloses that said indication of a product category including at least two products or a service category including at least two services is received by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 5 and 33: Bergh and Scroggie and Von Kohorn disclose a method as in claims 1 and 29, and Bergh further discloses that said indication of a product category including at least two products or a service category including at least two services is received from at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 6 and 34: Bergh and Scroggie and Von Kohorn disclose a method as in claims 1 and 29, and Bergh further discloses that said indication of a product category including at least two products or a service category including at least two services is completed by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 8 and 35: Bergh and Scroggie and Von Kohorn disclose a method as in claims 7 and 29, and Bergh further discloses that said indication of said benefit is provided to at least one

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of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 9 and 36: Bergh and Scroggie and Von Kohorn disclose a method as in claims 7 and 29, and Bergh further discloses that said indication of said benefit is provided by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claim 11: Bergh and Scroggie and Von Kohorn disclose a method as in claim 10, and Bergh further discloses that said indication of a purchase is received from at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claim 12: Bergh and Scroggie and Von Kohorn disclose a method as in claim 10, and Bergh further discloses that said indication of a purchase is received by at least one of the following: a customer, a customer device, a retailer, retailer device, a seller, a seller device, or a controller (col 3, lines 17-25; col 1, lines 24-32; col 26, line 43-col 28, line 56).

Claims 13-15, 46, 47: Bergh and Scroggie and Von Kohorn disclose a method as in claim 1, 43.

Bergh further discloses receiving a customer identifier and determining a customer identifier (col 28, lines 47-56).

Bergh further discloses a purchase (col 27, line 65-col 28, line 2) and making a payment (col 19, lines 6-16).

Bergh does not explicitly disclose a payment identifier, receiving a payment identifier, that said payment identifier is customer identifier.



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However, Scroggie discloses a payment identifier, receiving a payment identifier, that said payment identifier is customer identifier (col 12, lines 18-22).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Scroggie's payment identifier to Bergh's purchase. One would have been motivated to do this because purchases can be efficiently tracked and completed utilizing payment identifiers.

Claim 25-28: Bergh and Scroggie and Von Kohorn disclose a method as in claim 1. Bergh further discloses a purchase (col 27, line 65-col 28, line 2) and making a payment (col 19, lines 6-16).

Bergh does not explicitly disclose a price or condition of purchase. However, Scroggie discloses providing an indication of or determining a price for said selected one of said at least two products or at least two services (col 13, lines 64-col 14, line 2 and col 18, lines 11-25).

Scroggie further discloses determining a condition or providing an indication of said condition of purchase of said selected one of said at least two products or at least two services (col 2, lines 59-65 and col 12, lines 8-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Scroggie's price or condition of purchase to Bergh purchase of an item or service. One would have been motivated to do this because price or condition of purchase is obvious information for making a purchase that lets a customer better determine if they desire to make a purchase.

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5. Claims 16, 22, 23, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergh (6,112,186) in view of Scroggie (5,970,469) in view of Von Kohorn (5,227,874) in further view of Kanter (5,537,314).

Claims 16 and 48: Bergh and Scroggie and Von Kohorn disclose a method as in claims 1 and 43. Bergh further discloses a penalty (col 19, lines 9-15) and making a purchase (col 27, line 65-col 28, line 2).

Bergh does not explicitly disclose a penalty if the product is not purchased.

However, Kanter discloses a referral recognition system for an incentive award program. Kanter further discloses a penalty for failing to purchase an item selected (col 10, lines 30-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Kanter's penalty for failed purchases to Bergh's recommendation and purchase method. One would have been motivated to do this so that Bergh can discourage purchases that are not possible.

Additionally, Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. In this case, Applicant merely states, 'is not purchased'. Examiner notes that the online Merriam Webster Dictionary at [www.m-w.com](http://www.m-w.com) defines 'purchase' as "**1 a** *archaic* : GAIN, ACQUIRE **b** : to acquire (real estate) by means other than descent or inheritance **c** : to obtain by paying money or its equivalent". Therefore, it is inherent to a purchase that the object or item actually be acquired or obtained. If the object or item was not acquired or obtained, then no purchase was made.

Hence, Bergh discloses purchasing (col 27, line 65-col 28, line 2) and discloses a penalty for communications that are deemed not worthwhile (col 9, lines 9-17). Bergh further discloses sending failure notifications for user actions that are unsuccessful (col 31, lines 32-35).

Kanter discloses that, when utilizing checks, checks run the risk of not clearing and that there can then be a penalty fee (col 10, lines 30-35). Kanter further discloses purchasing (col 2, lines 18-22). Additionally, It is inherent to checks that they can be utilized for purchasing.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Kanter's penalty for failed funding utilized for purchases to Bergh's penalties in a recommendation and purchasing method. One would have been motivated to do this in order to better assure that a user is able to complete what they attempt to purchase.

Claim 22: Bergh and Scroggie and Von Kohorn disclose a method as in claim 1. Bergh further discloses an indication of a penalty (col 19, lines 9-15) and making a purchase (col 27, line 65-col 28, line 2).

Bergh does not explicitly disclose providing an indication of a penalty if the product is not purchased.

However, Kanter discloses a referral recognition system for an incentive award program. Kanter further discloses a penalty for failing to purchase an item selected (col 10, lines 30-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Kanter's penalty for failed purchases to Bergh's recommendation and purchase method. One would have been motivated to do this so that Bergh can discourage purchases that are not possible.

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Additionally, Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. In this case, Applicant merely states, 'is not purchased'. Examiner notes that the online Merriam Webster Dictionary at [www.m-w.com](http://www.m-w.com) defines 'purchase' as "1 *a archaic* : GAIN, ACQUIRE *b* : to acquire (real estate) by means other than descent or inheritance *c* : to obtain by paying money or its equivalent". Therefore, it is inherent to a purchase that the object or item actually be acquired or obtained. If the object or item was not acquired or obtained, then no purchase was made.

Hence, Bergh discloses purchasing (col 27, line 65-col 28, line 2) and discloses a penalty for communications that are deemed not worthwhile (col 9, lines 9-17). Bergh further discloses sending failure notifications for user actions that are unsuccessful (col 31, lines 32-35).

Kanter discloses that, when utilizing checks, checks run the risk of not clearing and that there can then be a penalty fee (col 10, lines 30-35). Kanter further discloses purchasing (col 2, lines 18-22). Additionally, It is inherent to checks that they can be utilized for purchasing.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Kanter's penalty for failed funding utilized for purchases to Bergh's penalties in a recommendation and purchasing method. One would have been motivated to do this in order to better assure that a user is able to complete what they attempt to purchase.

Claim 23: Bergh and Scroggie and Von Kohorn disclose a method as in claim 1. Bergh further discloses arranging for a penalty (col 19, lines 9-15) and making a purchase (col 27, line 65-col 28, line 2).

Bergh does not explicitly disclose arranging for a penalty if the product is not purchased.

However, Kanter discloses a referral recognition system for an incentive award program. Kanter further discloses a penalty for failing to purchase an item selected (col 10, lines 30-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Kanter's penalty for failed purchases to Bergh's recommendation and purchase method. One would have been motivated to do this so that Bergh can discourage purchases that are not possible.

Additionally, Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. In this case, Applicant merely states, 'is not purchased'. Examiner notes that the online Merriam Webster Dictionary at [www.m-w.com](http://www.m-w.com) defines 'purchase' as "1 a *archaic* : GAIN, ACQUIRE b : to acquire (real estate) by means other than descent or inheritance c : to obtain by paying money or its equivalent". Therefore, it is inherent to a purchase that the object or item actually be acquired or obtained. If the object or item was not acquired or obtained, then no purchase was made.

Hence, Bergh discloses purchasing (col 27, line 65-col 28, line 2) and discloses a penalty for communications that are deemed not worthwhile (col 9, lines 9-17). Bergh further discloses sending failure notifications for user actions that are unsuccessful (col 31, lines 32-35).

Kanter discloses that, when utilizing checks, checks run the risk of not clearing and that there can then be a penalty fee (col 10, lines 30-35). Kanter further discloses purchasing (col 2, lines 18-22). Additionally, It is inherent to checks that they can be utilized for purchasing. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Kanter's penalty for failed funding utilized for purchases to Bergh's

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penalties in a recommendation and purchasing method. One would have been motivated to do this in order to better assure that a user is able to complete what they attempt to purchase.

6. Claims 97 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bergh (6,112,186) in view of Scroggie (5,970,469) in view of Von Kohorn (5,227,874) in further view of Tozzoli (5,717,989).

Claim 97: Bergh and Scroggie and Von Kohorn disclose a method as in claim 1.

Von Kohorn further discloses receiving, from the customer, an intention to purchase a one of the first product and the second product that is selected for the customer and tracking purchases that a user did not make despite his intention (col 3, lines 21-31; col 78, lines 40-48)

Von Kohorn further discloses advertising items with specific sale terms (col 104, line 65- col 105, line 3; col 105, lines 17-24).

Von Kohorn does not explicitly disclose a binding commitment towards a purchase.

However, Tozzoli disclose a binding commitment towards a purchase (col 3, lines 48-56).

Tozzoli further discloses advertising items with specific sale terms (col 6, lines 45-48).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Tozzoli's binding commitment to Von Kohorn's intention to make a purchase and Bergh's purchasing. One would have been motivated to do this in order to better ensure that intended purchases are fulfilled.

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***Response to Arguments***

7. Applicant's arguments with respect to claims 1-23, 25-41, 43-97 have been considered but are moot in view of the grounds of the rejection above.

Particularly note the rejection of the Independent claims above.


Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

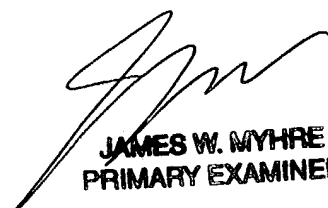
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
6/10/04

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**